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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,666	02/22/2000	Hans Kodeda	250/002	2852

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EXAMINER

FLORES RUIZ, DELMA R

ART UNIT	PAPER NUMBER
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2828

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/510,666	KODEDA ET AL.	
	Examiner	Art Unit	
	Delma R. Flores Ruiz	2828	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.


- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1 - 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 16 the terms "optical element" in claim 1 and 16 are a relative terms which renders the claim indefinite. The terminology "Optical element" is ambiguous and unclear since the one of ordinary skill in the art would have not been able to understand what device the applicant is referring, for example, the following devices could be consider an optical element: mirror, lenses, telescope, laser, scanner, camera, microscope, magnifying glass, glass of water, crystal, prism etc.

With respect to claims 1 and 16 :

A) The recitation "extraction portion" is unclear since one of ordinary skill in the art would have not understand what applicant means by said recitation since is not clear defined structure. The examiner suggests to clarify with apparatus components with clearly stated functions and structural relationship.

B) The recitation "gripping portion in the device" is unclear for the same reasons stated above.

C) The extraction portion and retainer is unclear. The components claimed are not limiting the apparatus since structural relationship is not clear. Clarification is required.

In claims 2 and 17, the recitation "holder rotateable within the retainer about a common axis, and rotation of the holder rotate the optical element" is unclear since one of ordinary skill in the art would not understand what applicant intends with said recitation. The examiner suggests the applicant to clarify the components being rotated into the structure and its structural relationship with the other components.

In claim 3, the recitation " the axis of rotation is also common with the optical element " is unclear since one of ordinary skill in the art would not understand what applicant intends with said recitation. The examiner suggests the applicant to clarify the components into the structure and its structural relationship with the other components.

Claim 4 and 14 recites the limitation "mounting structure comprising " in claim 4, line 2. There is insufficient antecedent basis for this limitation in the claim.

In claims 4 and 14, the recitation " mounting structure" is unclear since one of ordinary skill in the art would not understand what applicant intends with said recitation. The examiner suggests the applicant to clarify the components into the structure and its structural relationship with the other components.

In claims 6 and 22 the recitation " retainer is threadably engaged with the mounting structure " is unclear since one of ordinary skill in the art would not understand what applicant intends with said recitation. The examiner suggests the applicant to clarify the components into the structure and its structural relationship with the other components.

In claim 16 – 34 , the applicant lacks structural limitations in order to have a clear claim for example, resonator cavity, active gas medium, pumping means, and structural means. One of ordinary skill in the art would not understand what applicant intends. The examiner suggests the applicant to clarify the components into the structure, its structural relationship with the other components and the function of each component.

In claim 17 the applicant fails to claim the intended device since is unclear to what device is referred to. One of ordinary skill in the art would not understand what applicant intends. The examiner suggests the applicant to clarify the components into

the structure, its structural relationship with the other components and the function of each component.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 8, 10 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Vodzak et al. (5,857,775).

Vodzak disclose on Figures 7, 11, 12, 13, and 14, the claimed limitations. However the claimed limitations or components where not numbered at the reference and therefore, the examiner in order to clarify the components not numbered at the Figures 7, 11, 12, 13, and 14, is numbering said components. The following rejection makes reference to the numbers assigned by the examiner.

Regarding claim 1 Vodzak disclose, on Figures 7, 11, 12, 13, and 14,, an optical element (see Fig. 14, Character 511) holding and extraction device (see Fig. 14 Character 5) comprising: an optical element (see Fig. 14 Character 1); an optical element holder comprising a tubular gripping portion (see Fig. 7 Characters 329, and

355, Fig. 14 Character 2 and 3) and a tubular extraction portion (see Fig. 14 Character 5) connected at one end to the tubular gripping portion (see Fig. 14, Character 2 and 30) and having a diameter less than the tubular gripping portion, the tubular gripping portion gripping the peripheral edge of the optical element; a retainer slideably (see Fig. 14 Character 4) carried on the tubular extraction portion (Column 5, lines 58 – 62, Column 6, lines 58 – 67, Column 7, and lines 1 – 60).

Regarding claim 2 Vozzak disclose, on Figures 7, 11, 12, 13, and 14,, wherein the holder is rotateable within the retainer about a common axis and rotation of the holder the optical element.

Regarding claim 3, and 7 Vozzak disclose, on Figures 7, 11, 12, 13, and 14, wherein the retainer (character 5) comprises an externally threaded sleeve (see Fig. 14 Character 6); the optical element (see Fig. Character 1) is substantially round; and the axis of rotation is also common with the optical element.

Regarding claims 4, 5, 6, and 8 Vozzak disclose, on Figures 7, 11, 12, 13, and 14, a mounting structure comprising an optical element receiving surface, wherein the retainer is removably engaged with the mounting structure and secures the optical element against the optical element receiving surface, a seal (see Fig. 14 Character

528) interposed between the optical element, the optical element receiving surface and the retainer is threadably engaged with the mounting structure, the tubular gripping portion comprises a shoulder that is interposed between the retainer and the optical element.

Regarding claims 10, 11, and 13 Vodzak disclose, on Figures 7, 11, 12, 13, and 14, a catch (see Fig. 14 Character 526) disposed on the exterior surface of the tubular extraction portion at an end opposite to the end connected to the gripping portion and the catch and stop is selected from the group consisting of a snap ring (see Fig. 14, Character 526) and detent (see Fig. 14, Character 526).

Regarding claims 12, 14, and 15 Vodzak disclose, on Figures 7, 11, 12, 13, and 14, the gripping portion comprises an annular clip in which the optical element is receiver and a stop provided on the inner surface of the annular chip, the mounting structure comprises a flexible tube element comprising a base and an optical element receiving end, an optical element receiving surface within the flexible tube element proximate to the receiving end, and a flexible section interposed between the base end and the receiving surface, and the flexible section comprises a bellows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vozzak et al. (5,857,775) in view of Chenausky (5,748,663).

Regarding claims 16 – 34 Vozzak discloses a an optical element (see Fig. 14, Character 511) holding and extraction device (see Fig. 14, Character 5) comprising: an optical element (see Fig. 14 Character 1); an optical element holder comprising a tubular gripping portion (see Fig. 14 Characters 2 and 3) and a tubular extraction portion (see Fig. 14, Character 5) connected at one end to the tubular gripping portion and having a diameter less than the tubular gripping portion, the tubular gripping portion gripping the peripheral edge of the optical element; a retainer slideably (see Fig. 14 Character 4) arranged on the tubular extraction portion, the holder is rotatable within the retainer about a common axis and rotation of the holder the optical element, the retainer (see Fig. 14, Character 5) comprises an externally threaded sleeve (see Fig. 14, Character 6); the optical element (see Fig. 14 Character 1) is substantially round; and the axis of rotation is also common with the optical element, a mounting structure

comprising an optical element receiving surface, wherein the retainer is removable engaged with the mounting structure and secures the optical element against the optical element receiving surface, a seal (see Fig. 14, Character 528) interposed between the optical element, the optical element receiving surface and the retainer is threadably engaged with the mounting structure, the tubular gripping portion comprises a shoulder that is interposed between the retainer and the optical element, a catch (see Fig. 14, Character 526) disposed on the exterior surface of the tubular extraction portion at an end opposite to the end connected to the gripping portion and the catch and stop is selected from the group consisting of a snap ring (see Fig. 14, Character 526) and detent (see Fig. 14, Character 526), the gripping portion comprises an annular clip in which the optical element is receiver and a stop provided on the inner surface of the annular chip, the mounting structure comprises a flexible tube element comprising a base and an optical element receiving end, an optical element receiving surface within the flexible tube element proximate to the receiving end, and a flexible section interposed between the base end and the receiving surface, and the flexible section comprises a bellows.

Vodzak disclose the claimed invention except for the gas laser incorporated at the claimed structure. It would have been obvious at the time of applicant's invention, to combine Chenausky of teaching a the gas laser incorporated at the claimed structure with optical element because was made to accommodated the laser device inside the holding structure since holding the laser will make the system more precise and

statically stable and advantageously avoid the laser from being damage or deteriorated by exterior causes. Holding the laser could also have many other possible advantages that one of ordinary skill in the art could have recognized, for example, rotating the laser device through the holding device in order to obtain the light emission in a specific and desired inclination with respect to the plane where the light is directed. The recitation that a gas laser has not been given patentable weight because i t has been held that a preamble is denied the effect of a limitation where the claim following the preamble is a self-contained description of the structure not depending for complete ness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

Response to Arguments

Applicant's arguments with respect to claims 1 – 34 have been considered but are moot in view of the new ground(s) of rejection.

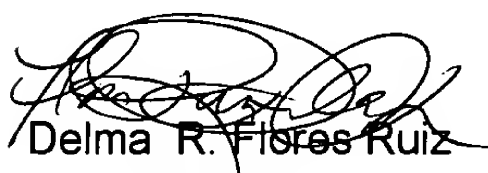
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delma R. Flores Ruiz whose telephone number is (703) 308-6238. The examiner can normally be reached on M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the

organization where this application or proceeding is assigned is (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.



Delma R. Flores Ruiz
Examiner
Art Unit 2828



Paul Ip
Supervisor Patent Examiner
Art Unit 2828

DRFR/PI
October 31, 2002